

*Application No. 10/804,495***RECEIVED
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DEC 20 2006****REMARKS**

Claims 21-32 are pending in the application with claims 21, 22, 27, and 28 amended herein. Page 2 of the Office Action requests an update to the status of the parent application. The specification amendment made herein corrects the specification accordingly.

Page 2 of the Office Action alleges that the distinction between claims 22 and 23 and between claims 28 and 29 is unclear. Accordingly, claims 22 and 28 are amended herein to set forth a clear distinction between respective claims 23 and 29.

Claims 21-32 stand rejected under 35 U.S.C. 112, first paragraph as allegedly lacking an enabling disclosure in the specification. Without admitting to the propriety of the rejection, claims 21 and 27 are amended herein to set forth a non-polymeric urethane resin. Page 2 of the Office Action acknowledges that the specification provides an enabling disclosure of non-polymeric reaction products. Consequently, Applicant requests withdrawal of the lack of enablement rejection in the next Office Action. Claims 22-26 depend from claim 21 and claims 28-32 depend from claim 27.

Claims 27-30 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hays (U.S. 5,041,477). Applicant requests reconsideration.

Amended claim 27 sets forth a method of forming a phase change ink that includes, among other features, reacting one or more alcohols with one or more isocyanates and producing a non-polymeric urethane resin. The alcohols contain fused-ring alcohols which include at least three fused rings.

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The method involves including the resin in a phase change ink composition. Page 3 of the Office Action alleges that Hays discloses each and every limitation of claim 27. Applicant traverses.

Page 3 of the Office Action alleges that the oligomeric reaction product of isocyanates and rosin-based capping agents discloses the reaction set forth in claim 27. The Office Action refers to column 7, lines 23-26 of Hays, among other portions of Hays. However, review of the relied upon text and the remainder of Hays fails to reveal disclosure of reacting isocyanates with rosin-based capping agents, such as hydroabietyl alcohol. Instead, at least column 6, lines 6-46 discuss the use of capping reactants in Hays and expressly state in lines 31-33 that capping reactants are only reacted with the oligomeric reaction product, such as described in column 4, lines 7+. Applicant asserts that Hays does not disclose and the Office Action does not identify disclosure of reacting capping reactants with isocyanates. Indeed, the very name of such agents ("capping reactants") describes reaction with the oligomeric reaction product to form the "CAP", such as shown in column 4, lines 10-22, which identifies the capping moieties. At least for such reason, Hays fails to disclose each and every limitation of claim 27.

In addition, amended claim 27 sets forth including a non-polymeric urethane resin in a phase change ink composition. Review of Hays fails to reveal disclosure of phase change ink. Applicant acknowledges description of an oligomeric aromatic dispersant used in oil-based printing inks in column 3, lines 21+. However, such discussion does not necessarily disclose including non-polymeric urethane resin in a phase change ink composition, as

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set forth in claim 27. The Office Action does not allege any basis in fact and/or technical reasoning to reasonably support some determination that Hays may be considered to disclose every limitation of claim 27. At least for such further reason, Hays fails to disclose each and every limitation of claim 27 and does not anticipate such claim. Claims 28-30 depend from claim 27 and are not anticipated at least for such reason as well as for the additional limitations of such claims not disclosed.


Claims 21-32 stand provisionally rejected for obviousness-type double patenting over certain claims corresponding to patent applications listed on page 4 of the Office Action. Applicant asserts that all pending claims are otherwise allowable and requests withdrawal of the provisional obviousness-type double patenting rejection.

Claims 21-32 stand rejected for obviousness-type double patenting over certain claims corresponding to patents listed on pages 5-6 of the Office Action. Applicant herewith submits a timely-filed terminal disclaimer overcoming the double patenting rejection. Applicant requests withdrawal of the double patenting rejection in the next Office Action.

Applicant herein establishes adequate support for patentability of claims 21-32 and requests allowance of all claims in the next Office Action.

Respectfully submitted,

Dated: 20 Dec 2006

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